REMARKS

Status of the Claims

Claims 1-2, 6-7, 15-17, 20-25, and 28-30 were previously pending and stand rejected. The *Office Action* made no mention of previously pending claim 31 or new claims 32-37, the latter of which were introduced through the *Request for Continued Examination* dated November 1, 2006. Claims 1-2, 6, 25, and 31 are amended herewith; claims 38-80 are new. Of new claims 38-80, claims 38 and 59 are in independent form.

35 U.S.C. § 103(a) Rejection of Independent Claims 1 and 6

- *LOGAN & MANKOVITZ* FAIL TO DISCLOSE A 'DEVICE CONFIGURATION SETTING'

The Examiner continues to contend that claims 1 and 6 are obvious in light of U.S. patent number 5,371,551 to Logan (*Logan*) in view of U.S. patent number 5,541,738 to Mankovitz (*Mankovitz*), and now in further view of official notice. See *Office Action*, 2. The Applicants continue to traverse with respect to, at the least, the recitation of "one or more device configuration settings [being] configured via a user interface over a network connection" in claims 1 and 6.

The 'variable delay interval' referenced by the Examiner in *Logan* is a time interval controlling *when* recorded program signals are displayed versus the time they are recorded. See *Office Action*, 3. This interval is more akin to delayed **playback** control rather than the Applicants' claimed '**device configuration settings**.' As exemplified in (for example) claims 32-37, device configuration settings may control parameters such as record timers, video quality settings, channel tuning, and so forth. See *supra* claims 32-37; see also *Specification*, 5 (3.11 Network-Controlled Configurability); contra claims 15, 23 (concerning playback controls such as play, stop, pause, rewind, and fast-forward).

● THE COMBINATION OF *LOGAN, MANKOVITZ* AND *OFFICIAL NOTICE* RESULTS IN AN INCOMPATIBLE COMBINATION

Claims 1 and 6 recite, *inter alia,* "receiving one or more audio/video programs" including "data about the programs, the data . . . provided over a network connection" and "wherein the network connection comprises an Internet connection." The Examiner admits, however, that "Logan et al fails to specifically disclose the feature of the audio/video programs being associated with data about the programs, the data about the programs being provided over a network connection." *Office Action,* 3. For this particular claim element, the Examiner turns to *Mankovitz,* which purportedly discloses "data about the programs being provided over a network connection." *Office Action,* 3. The Examiner also admits that "the proposed combination of Logan et al and Mankovitz . . . fails to specifically disclose the feature of the network connection comprising an [I]nternet connection." *Office Action,* 4. For this claim element, the Examiner states that "it is notoriously well known in the computer network art to have a network connection including access to the [I]nternet through an [I]nternet connection as specified in the claimed invention." *Office Action,* 4.

While the Applicants do not contest the fact that the Internet was notoriously well known in the computer networking arts in 1998 (the time the present application was filed), the Applicants do contest the compatibility—and thus the motivation to combine—*Logan, Mankovitz,* and the official notice taken by the Examiner with respect to the Internet. See *MPEP* § 2143.01(I) (concerning the requirement that the prior art must suggest the desirability of the claimed invention); see also *In re Litner,* 458 F.2d 1013, 1016 (CCPA 1972) (noting that "it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification").

The Examiner refers — specifically — to components 63 and 64 of *Mankovitz*, which disclose an antenna and cable TV source, respectively. See *Mankovitz* at col. 4, l. 12-14; see also Figure 1 (reproduced in part, below). As can be seen in the reproduced portion of Figure 1 from *Mankovitz*, the antenna (63) and cable TV source (64) are coupled to a tuner (61), which is in turn coupled to a VBI decoder 60a. See *Mankovitz* at col. 4, l. 9-14.

To the extent that *Mankovitz* discloses the transmission of data about a program (see *Mankovitz*, col. 4, l. 40-41), that information is included as a part of the VBI — the Vertical Blanking Interval — which is the time between the last line of a frame or field and the beginning of the next frame or field in an analog, VGA, or DVI signal. **There is no VBI in an Internet Protocol (IP) transmission as would occur over an Internet connection.**
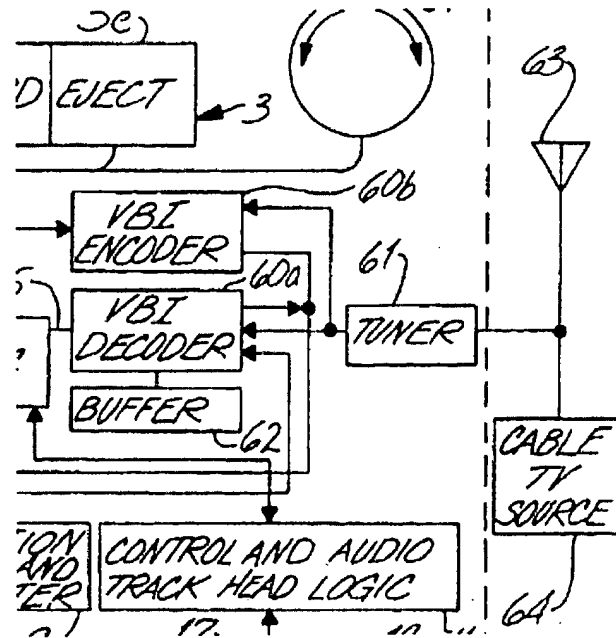
Per *Mankovitz*, "VBI data is placed in a broadcast TV signal by a broadcast TV station." *Mankovitz*, col. 4, l. 29-30. "Under control of the decoder [60a], all VBI data received by the VBI decoder 60a [via the antenna 63 or cable TV source 64] is stored in the caption buffer [62] and serially output to the VCR control logic circuit 21." *Mankovitz*, col. 4, l. 35-37. The Internet, however, operates utilizing IP transmissions— addressed packets of data. **There are no lines, frames, or fields in a packet of data transmitted utilizing IP; as such, there can be no VBI.** As there can be no VBI transmitted utilizing IP over the Internet, there is no reasonable expectation of success— and thus no motivation to combine—the teachings of *Mankovitz* and the knowledge of the existence of the Internet as posited by the Examiner.

In this context, the Applicants reference the MPEP, which states that:

> [w]hen applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be **considered as a whole**; (B) The **references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination**; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) **Reasonable expectation of success is the standard with which obviousness is determined.**

MPEP § 2141 (citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)) (emphasis added). When considering the presently claimed invention (which is inclusive of an Internet connection) in the context of the references as a whole (a broadcast VBI v. an IP-based packet transmission over the Internet), **one of ordinary skill in the art cannot conclude that there is a reasonable expectation of success in light of the incompatibility of an IP-based data packet transmission over the Internet and a VBI.** As such, there is no motivation to combine *Logan*, *Mankovitz*, and the official notice of the Internet with respect to the present claimed invention set forth in claims 1 and 6. As such, there is no *prima facie* case of obviousness and the Examiner's rejection is overcome. See *MPEP § 2143* (concerning the requirement that the reasonable expectation of success be found in the prior art).

As noted in the STATUS OF THE CLAIMS section (above), no mention was made with respect to the patentability of independent claim 31, dependent claims 32-37, or the merits of the Applicants' previously submitted arguments. See *Amendment F*, 7-8. As such, the Applicants respectfully contend the November 2006 *Office Action* to be incomplete and request that any further action to be non-final in nature in order to address any possible subsequent rejection of claims 31-37. See *MPEP* § 707.07 (citing 37 C.F.R. § 1.104 (requiring the action to "be complete as to *all* matters") (emphasis added)).

Patentability of New Independent Claims 38 and 59

- **Claim 38**

    New claim 38 recites as follows:

    > A method for time-delayed viewing of audio/video content, comprising:
    > receiving audio/video content from an audio/video source;
    > receiving a playback control command from a viewer of the
    > audio/video content, the playback control command
    > received in response to the viewer having viewed at least a
    > portion of the audio/video content; and
    > storing at least a portion of the audio/video content in archival
    > memory, wherein the stored portion of the audio/video
    > content includes a control code corresponding to the
    > received playback control command and that may be used
    > to control subsequent playback of the stored portion of the
    > audio/video content.

    An embodiment of claim 38 may allow for 'save-with-edit' functionality. In such an embodiment, the method may allow for capture of viewer input as it pertains to, for example, playback commands such as the start and stop of a fast forward command. Control codes corresponding to when/where in audio/video content the

19

playback command was issued may be saved to memory along with the actual audio/video content. During subsequent playback of the saved content, the control codes may be recognized by playback software such that the previously issued playback commands are automatically executed.

For example, a viewer may 'fast forward' past a commercial by issuing a fast forward command at the commencement of the commercial and terminating that command at the end of that commercial. The audio/video content (*e.g.*, a television program including the commercial) may be saved to memory along with the control codes pertaining to the fast forward commands. During subsequent playback of the content (*i.e.*, the television program and commercial), the control codes corresponding to the fast forward command are recognized and automatically executed such that the commercial is automatically 'fast forwarded' through without any further intervention by the viewer.

In some embodiments (like that disclosed in claim 47), the 'fast forwarded' portion of content may not be saved to memory. In such an embodiment, subsequent playback of the larger portion of audio/video content may simply 'skip' over the non-existent/non-saved portion of content (*e.g.*, the commercial). Such an embodiment may be useful with respect to saving storage space in memory. The specification discloses embodiments like those found in claims 33 and 47, at the least, on page 1 from lines 32-33 and page 5 from lines 8-22. *Logan, Mankovitz,* nor any other reference discussed by the Examiner offers such 'save-with-edits' functionality and, as such, claims 38 and 47 are in condition for allowance.

- **Claim 59**

New claim 59 recites:

> A method for time-delayed viewing of audio/video content, comprising:
>> simultaneously receiving audio/video content from a plurality of audio/video sources, wherein each of the plurality of audio/video sources corresponds to a channel and each of the channels corresponds to a dedicated portion of buffer memory at a digital recorder device;
>> simultaneously storing audio/video content received from each of the plurality of audio/video sources in the corresponding portion of buffer memory at the digital recorder device; and
>> playing back from a first dedicated portion of buffer memory the corresponding stored audio/video content received from a first channel corresponding to a first of the plurality of audio/video sources, wherein the audio/video content in the first dedicated portion of buffer memory is not simultaneously overwritten when a viewer changes from the first channel to a second channel corresponding to a second of the plurality of audio/video sources.

An embodiment of claim 59 may allow for saving a 'multi-channel recording session.' For example, a viewer may simultaneously receive content on a number of channels (*e.g.*, channels 1, 2, and 3) with the content from each of those channels being saved to dedication portions of memory. A viewer may control content from the portion of memory dedicated to channel 1 (*e.g.*, fast-forward, rewind, pause, etc.) and then subsequently change to another channel (*e.g.*, to channel 2) without interrupting continued recording of or overwriting prior recording of content to memory for channel 1. The same may be true when the viewer changes from channel 2 to channel 3 or from channel 2 back to channel 1. Memory (subject to size limitations) continues recording on all designated channels regardless of what channel the viewer may presently be viewing and/or controlling.

21

Such an embodiment differs from presently available digital video recorders that 'flush' all content from a buffer associated with a first or current channel when the viewer changes to a subsequent channel. Such an embodiment may prove particularly useful in those instances when a user inadvertently changes channels but did not wish to flush previously recorded content from memory.

Some embodiments (*e.g.*, claim 71) may allow a user to save an entire viewing or channel surfing session. In such an embodiment, all channel changes may be recorded to memory offering subsequent playback of a viewer's 'television watching experience' through multiple channels without intermediate 'flushing' of content in memory. The specification discloses embodiments like those found in claim 59 and 71, at the least, on page 4, line 26-page 5, line 4. *Logan, Mankovitz,* nor any other reference discussed by the Examiner offers such 'multi-channel recording' nor 'television watching experience' functionality and, as such, claims 59 and 71 are in condition for allowance.

Patentability of Dependent Claims

"A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." 35 U.S.C. § 112, ¶ 4. As such, the dependent claims of the present application are allowable for at least the same reasons as the independent claim from which they depend.

CONCLUSION

The art discussed by the Examiner fails to disclose 'device configuration settings' as recited in claims 1, 6, and 31. The art discussed by the Examiner also lacks a motivation to combine in that *Logan, Mankovitz,* and the official notice of the Internet result in an incompatible combination with respect to the aforementioned claims.

The art discussed by the Examiner does not evidence the 'save-with-edits' functionality of new claim 38 nor does it disclose the 'multi-channel recording' functionality of claim 59. The dependent claims of the present application are allowable, at the least, by virtue of their dependence on claim 1, 6, 31, 38, or 59.
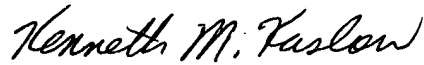
The Examiner failed to consider claims 32-37 in the prior office action making that action incomplete. Any further action should consider these claims and be non-final in nature in order to give the Applicants a full and fair opportunity to respond to any rejection of the same.

The Examiner is invited to contact the Applicants' undersigned representative with any questions at the number set forth below.

Respectfully submitted,
Richard A. Lang et al.

March 12, 2007   By: *Kenneth M. Kaslow*
                                              Kenneth M. Kaslow, Reg. No. 32,246
                                              CARR & FERRELL *LLP*
                                              2200 Geng Road
                                              Palo Alto, CA 94303
                                              T: 650.812.3400
                                              F: 650.812.3444